

REMARKS

Claims 19, 32, 43, 53, 67-69, 73 and 76-79 have been amended and claim 70 has been canceled. Claims 1-69 and 71-90 are pending in the application. Reconsideration of the application, and an action on the merits, are respectfully requested in view of the amendments and the remarks to follow.

Response to Restriction:

The Office Action states (page 2), that of pending claims 1-90, restriction is required between:

Group I: claims 1-75, allegedly drawn to a stacked capacitor;

Group II: claims 76-79, allegedly drawn to a process for charging a floating electrode; and

Group III: claims 80-90, allegedly drawn to charge storage machination.

Applicant provisionally elects the claims of Group I with traverse, as is discussed below in more detail.

The Office Action states (pp. 2, item 2) that "The inventions are distinct, each from the other, because of the following reasons: Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP §806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the storage machination does not require the specifics of the

stacked capacitor. The subcombination has separate utility such as a stacked capacitor use in a device other than a storage machination.

Inventions (I and III) and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be used with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP §806.05(h))." The Office Action also alleges that "In the instant case the capacitor can be charged without the specific injection/extraction means of II."

The Office Action further states (page 3) that, "Should applicant select Group I or III, the application contains claims directed to the following patentably distinct species:

Embodiment I: figure 3;

Embodiment II: figure 4;

Embodiment III: figure 5;

Embodiment IV: figure 6;

Embodiment V, figure 7."

Applicant elects the species of Fig. 3, which is further described with reference to Figs. 4-10, the specification and claims 1-90. Fig. 3 is a schematic diagram and thus is generic with respect to any embodiments disclosed in this application (see, e.g., the Figs., at least as noted above and in the Office Action, and also accompanying text).

The Office Action further states (p. 3) that "Currently, none of the claims are generic." Applicant notes that claim 1 "reads on" the embodiments of at least

Figs. 3-7. Applicant notes the definition of "generic claim" provided in MPEP 806.04(d), entitled "Definition of a Generic Claim". This MPEP section states that:

In an application presenting three species illustrated, for example, in Figures 1, 2, and 3, respectively, a generic claim should read on each of these views; but the fact that a claim does so read is not conclusive that it is generic. It may define only an element or subcombination common to the several species.

It is not possible to define a generic claim with that precision existing in the case of a geometrical term. In general, a generic claim should include no material element additional to those recited in the species claims, and must comprehend within its confines the organization covered in each of the species.

For the purpose of obtaining claims to more than one species in the same case, the generic claim cannot include limitations not present in each of the added species claims. Otherwise stated, the claims to the species which can be included in a case in addition to a single species must contain all the limitations of the generic claim.

Applicant has amended previously-independent claims 19, 32, 43, 53, 67 and 76 to depend from claim 1. Applicant has also amended dependent claims 68, 69, 73 and 77-79 and canceled claim 70 to address resulting minor informalities. However, these amendments are not intended to alter the scope of the claims.

Conclusion

Claims 1-69 and 71-90 are in condition for allowance. Applicant respectfully requests reconsideration and issuance of the subject application. Should any matter in this case remain unresolved, the undersigned attorney respectfully requests a telephone conference with the Examiner to resolve any such outstanding matter.

Respectfully Submitted,

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